IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|---|---|---|
| In re Application of: | ) | Art Unit: 1654 |
| DJURUP, et al. | ) | Examiner: GUDIBANDE, S. |
| Serial No.: 10/524,434 | ) | Washington, D.C. |
| Filed: February 15, 2005 | ) | June 25, 2009 |
| For: BACTERICIDAL, ANTI-APOPTOTIC, PRO-INFLAMMATORY AND... | ) | Docket No.: DJURUP=1 |
| | ) | Confirmation No.: 4128 |

**PETITION TO VACATE ERRONEOUS NOTICE TO COMPLY WITH SEQUENCE LISTING REQUIREMENTS**

U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

S i r :

1. In response to the June 18, 2009 notice to comply with sequence listing requirements, applicants respond by petitioning to vacate the present requirement as erroneous. Supervisory review under 37 CFR 1.181 is respectfully requested.

Applicants filed a sequence listing, in paper and computer-readable form, on October 20, 2005.

The alleged deficiency in this sequence listing is set forth in section 7 of the notice:

> Amended claim 1 recites 'X1 is amino acids 1-5 of SEQ ID Nos: 595, 600, 605 or 606". The instant specification does not have a sequence listing corresponding to amino acid 1-5 of SEQ ID Nos: 595, 600, 605 or 606. Applicant are required to comply with the Sequence listing rules as set forth in 37 C.F.R. 1.821 - 1.825.

However, MPEP 2422.03 clearly states

> Sequence identifiers can also be used to

> discuss and/or claim parts or fragments of a properly presented sequence. For example, language such as "residues 14 to 243 of SEQ ID NO:23: is permissible and the fragment need not be separately presented in the "Sequence Listing".

Since the sequences with SEQ ID Nos: 595, 600, 605 and 606 are presented in full in the sequence listing, it is not necessary to separately present the recited fragment (amino acids 1-5) of these sequences. Hence, the June 18 requirement is erroneous and should be vacated.

2. While not part of our case for vacating the requirement, we wish to express our concern that June 18 office action sets both a one month SSP for response to the sequence listing requirement and a three month SSP for response to the action on the merits.

If the sequence listing requirement had been valid, then applicants would have needed to file an amendment to direct entry of a substitute sequence listing. If, by July 18, they were not ready to respond to the action on the merits, but were ready to respond to sequence listing requirement, and they filed an amendment responsive only to the sequence listing requirement, they would run the risk that the PTO would erroneously classify the amendment as a response to the action on the merits and then send applicants a notice of non-compliant amendment. Applicants would then have to petition to vacate that notice.

Moreover, it might be that in responding to the action on the merits, applicants would amend the claims so that they no longer recited "X1 is amino acids 1-5 of SEQ ID Nos: 595, 600, 605 or 606", which would then moot the sequence listing requirement.

It thus is clearly wasteful of both PTO and applicant resources to set a separate and earlier deadline for the sequence listing requirement. Rather when such a requirement accompanies

an action on the merits, the same period should be set as for the action on the merits, i.e., three months.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant

By: _____
Iver P. Cooper
Reg. No. 28,005

624 Ninth Street, N.W.
Washington, D.C. 20001
Telephone: (202) 628-5197
Facsimile: (202) 737-3528
IPC:lms
G:\ipc\g-i\hoib\Djurup1\djurup1.pto petition to vacate.wpd